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| 09/623,364      | 10/23/2000  | Alexci Khomutov      | 933-160P            | 2717             |

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EXAMINER

WHITE, EVERETT NMN

ART UNIT PAPER NUMBER

1623

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/623,364

Applicant(s)

KHOMUTOV ET AL.

Examiner

EVERETT WHITE

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

1. Claims 1-7 are objected to because of the following informalities: Claim 1, line 14, the passage "24, 21 and 18 for  $\alpha$ -,  $\beta$ - or  $\gamma$ -cyclodextrin, respectively" should be changed to --18, 21 and 24 for  $\alpha$ -,  $\beta$ - or  $\gamma$ -cyclodextrin, respectively--. The symbols " $\leq$ " and " $\geq$ " at line 14 of Claim 1 should be changed to --less than or equal to--and --greater than or equal to--, respectively. In Claims 2-6 at the beginning of each claim, the phrase "A derivative" should be changed to --The derivative--. In Claim 6, line 1, the term "claims" should be changed to --claim--. In Claim 7, the phrase "Any compound according to claim 1" should be changed to --The derivative according to claim 1--. Appropriate correction is required.

2. Claim 8 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-7 and 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as

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to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, Claim 1 recites the broad recitation 'ethoxy-ethylidene protected aminooxy', and the claim also recites "especially ethoxy-ethylidene protected aminooxy and acetone oxime derivatives thereof" which is the narrower statement of the range/limitation.

What is a direct bond as this term relates to X and Y in Claims 1 and 2? It appears that the claim is indicating that X and Y together form a bond that links the group  $\text{-ONH}_2$  directly to CD in formula 1. If this is the case, further clarification of the claimed language may be needed in Claims 1 and 2. Claim 3 is also rejected since Claim 3 is depending from Claims 1 and 2.

In Claim 1, lines 15 and 16, the metes and bounds of the term "aminooxy protected derivatives" cannot be determined which renders Claim 1 indefinite. It is difficult to determine what groups are attached to the aminooxy moiety without knowing what the groups are.

In Claim 4, at lines 8 and 12, the term "preferably" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

Proper Markush terminology is requested for Claim 5. This can be corrected by inserting the phrase "selected from the group consisting of—" after the phrase "X is" in line 2 of the claim.

Claim 6 set forth improper Markush terminology at line 5. This can be corrected changing the term "and" (2<sup>nd</sup> occurrence) in line 5 to "or--".

In Claim 7, at line 3, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding Claim 7, at line 8, the phrase "functional groups like" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

In Claim 7, at lines 5 and 6, the term "preferably" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

In Claim 10, the limitation "Oximes of any one of the aminoxy-CDs in Claim 1" lacks proper antecedent basis in Claim 1 which renders the claim indefinite.

In Claim 11, at lines 3 and 4, the term "preferably" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

#### ***Improper Use Claim***

5. Claim 9 provides for the use of the cyclodextrin derivatives of Claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Varaprasad et al (Bioorganic Chemistry, Vol. 14, pages 8-16, (1986)).

The Varaprasad et al reference discloses a product of a cyclodextrin derivative in the formula equation disclosed at the top of page 12 wherein the formula at Roman No. II indicates R<sub>1</sub> as representing a formula that is within the definition of the broadly claimed aminooxy protected derivative that is set forth in instant Claim 1. This formula of the Varaprasad et al reference anticipates the aminooxy-cyclodextrin derivative of Claim 1 when the aminooxy group is an aminooxy protected derivative.

### **Summary**

8. Claims 1-7 and 9-11 are rejected; Claim 8 is objected to.

### **Examiner's Telephone Number, Fax Number, and Other Information**

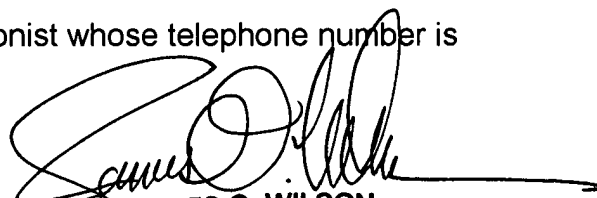
9. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at [www.uspto.gov](http://www.uspto.gov) and click on the button "Patent Electronic Business Center" for more information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter, can be reached on (703) 308-4532. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
E. White

  
JAMES O. WILSON  
PRIMARY EXAMINER  
GROUP 1623